

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB
DEC. 22, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sierra On-Line, Inc.

v.

Sierra Club

Opposition No. 96,402
to application Serial No. 74/392,967
filed on May 21, 1993

David A. Fanning and Walter W. Karnstein of Kolisch,
Hartwell, Dickinson, McCormack & Heuser for Sierra
On-Line, Inc.

Jonathan S. O'Donnell of Mandel Buder & Verges
for Sierra Club

Before Simms, Hanak and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Sierra Club filed, on May 21, 1993, an intent-to-use
application to register the mark SIERRA CLUB for "computer
programs."¹ An amendment to allege use was filed April 20,
1994, and subsequently accepted by the Office, in which the

goods were identified as "computer programs for use in screen saving applications." The mark was published for opposition on November 8, 1994 with the goods being inadvertently, and incorrectly, identified as "computer programs."

Sierra On-Line, Inc. filed an opposition to registration of the mark on two grounds, prior use and the likelihood of confusion under Section 2(d) and failure of applicant to describe its goods with the particularity required by 15 USC §1051 and 37 CFR §2.33.

Before proceeding any further, we must set the record straight as to the identification of goods presently in effect in the application. The application as filed set forth the goods as "computer programs." After the Examining Attorney found this identification to be unacceptable as being indefinite, applicant offered to amend the identification to "computer programs in the field of screen savers" or "computer programs for screen savers," but the Examining Attorney would not accept these identifications and made his refusal of the identification of goods final on February 18, 1994. The amendment to allege use was then filed on April 20, 1994 with the goods being identified as "computer programs for use in screen saving applications." The amendment to allege use was accepted and the application

¹ Serial No. 74/392,967, filed May 21, 1993, based on an

approved for publication. We assume that the amended identification of goods was found to be satisfactory by the Examining Attorney, inasmuch as the final refusal was withdrawn.

By an apparently inadvertent error, the amended identification of goods was never entered in the Office TRAM system and the mark was published for opposition with the original unacceptable identification of the goods as "computer programs." Opposer has based its opposition, in part, on the indefinite nature of this original identification of goods. Applicant, for reasons not known, has failed to point out that it had amended the identification of goods in its amendment to allege use. The trial should have proceeded on the basis of the amended identification of goods. Even though this was not the case, our decision is necessarily based on the goods being identified as "computer programs for use in screen saving applications." Opposer's opposition to registration on the ground that the identification of goods as "computer programs" as indefinite is moot and will be given no further consideration.

Accordingly, we have confined our attention to the allegations in the notice of opposition directed to priority and likelihood of confusion. As such, opposer alleges that

allegation of a bona fide intention to use the mark in commerce.

is has been engaged in making and selling entertainment software, including screen savers and computer games, educational software, and interactive software for many years; that it is the owner of registrations for the marks SIERRA and design² and SIERRA DISCOVERY for computer game programs;³ that it also owns the mark SIERRA for both computer game and entertainment programs and computer educational programs, which is the subject of a pending application with a claimed first use date of May 31, 1984;⁴ that it has common law rights in the mark SIERRA for screen savers, with use thereof since at least as early as October 8, 1992; and that applicant's use of the mark SIERRA CLUB on its goods is likely to cause confusion.

Applicant, in its answer, has denied the salient allegations of the notice of opposition.

The Record

² Reg. No. 1,386,598, issued March 18, 1986, for the mark

for "prerecorded computer programs for use in business and educational applications" in Class 9 and "computer game programs recorded on magnetic disks and tapes and on cartridges and ROMs" in Class 28. Sections 8 & 15 affidavits accepted and acknowledged, respectively.

³ Reg. No. 1,788,288, issued August 17, 1993, for the mark SIERRA DISCOVERY for "computer game programs on floppy discs and CD-ROMs."

⁴ Serial No. 74/494,166, filed February 23, 1994.

The record consists of the file of the involved application; opposer's trial testimony depositions, with exhibits, of John Williams, a long-time employee of opposer, and of Peter Beren, executive publisher and former licensing director of applicant, and Catherine Sigmon, current licensing director of applicant; opposer's first notice of reliance upon status and title copies of opposer's pleaded registrations and of Reg. No. 1,703,915,⁵ applicant's responses to opposer's interrogatories and requests for admission, several publications (Exhibits 5-9)⁶ and copies of applications Serial Nos. 74/494,166 and 74/642,868 filed by opposer; opposer's second notice of reliance upon copies of the files of its pending applications, both of which

⁵ Reg. No. 1,703, 915, issued July 28, 1992, for the mark THE SIERRA NETWORK for "computer services; namely, providing on-line access to remote users of entertainment and games applications programs and providing interconnect services among remote users." This registration was cancelled under Section 8 on February 2, 1999.

⁶ Applicant's objections to these exhibits, first raised in its brief, on the grounds that opposer did not explain the relevance thereof in its brief are not well taken. Opposer described the relevance of the material in its notice of reliance, as required under Trademark Rule 2.122(e). Applicant's objection to the reference by opposer in its brief to deposition testimony in too general terms to allow applicant to determine whether opposer is relying upon testimony objected to by applicant is also not well taken. In order to preserve these objections, applicant was required to readdress the objections in its brief, which it has not done. See TBMP § 718.04. Furthermore, opposer's references to testimony are clearly specific, in that both pages and lines of testimony are given.

currently stand suspended, and an article from Publishers Weekly, August 23, 1993.⁷

Both parties have filed briefs, and opposer a reply brief, but an oral hearing was not requested.⁸

John Williams, who was with opposer when it was formed as On-Line Systems, described the adoption by opposer of the Sierra designation in the early 1980's, after moving to a location in the Sierra Nevada mountain chain, first changing its name to Sierra On-Line and later using the designation Sierra alone. Williams testified that opposer had used its SIERRA mark on software products since the early 1980's, or at least by 1984, originally with game products but later broadening use to other products including educational and productivity software and screen savers. He specifically testified that opposer has used its SIERRA mark on computer

⁷ Applicant has filed a notice of reliance upon certain portions of the depositions of Cathy Sigmon and John Williams. Inasmuch as testimony depositions automatically constitute part of the evidentiary record for all purposes, the filing of a notice of reliance upon certain portions was unnecessary.

⁸ Opposer, on October 5, 1998, filed a motion to strike applicant's brief, on the basis of being untimely. Opposer correctly stated that applicant's brief was due no later than thirty days after the due date of opposer's brief, the latter date being August 21, 1998. Applicant did not file its brief until September 28, 1998. Although applicant argued, in response, that its brief was due thirty five days after service of opposer's brief, applicant was in error. Its brief was due September 21, 1998 and thus was late. Nonetheless, since it is in the interests of the Board to have both parties brief the issues which it must decide, opposer's motion to strike is denied. Applicant's brief has been considered. Opposer's alternative request to extend the time to file a reply brief is granted and the reply brief bearing a certificate of mailing date of October 13, 1998 has also been considered.

screen saver programs since 1992 and identified a copy of the packaging for a Johnny Castway screen saver bearing opposer's mark (Exhibit 6). Opposer's computer programs were described as being sold at retail outlets including electronics stores, software stores, computer retailers, and large warehouse stores such as Costco, and through mail order sales and the Internet. The estimated prices for the software range from \$5 to \$79. He testified to sales since 1984 of computer programs bearing the SIERRA mark in the tens of millions, with an estimated market share in the last four to six years of around 10% in the entertainment category. He stated that he was not aware of anyone else, other than applicant, using the term Sierra in connection with educational or entertainment computer programs.

Catherine Sigmon, the licensing director for applicant at the time of deposition, testified that applicant's entry into the computer software field was its licensing agreement with Microsoft for a screen saver program to be sold under the SIERRA CLUB mark. This software was first available in September 1993 (Exhibit 3), but sales were not very successful and the licensing agreement with Microsoft was allowed to expire as of January 1, 1997. She testified that applicant had also licensed its mark for use with other computer programs, including an agreement with GeoTrek for an electronic calendar and trail and camping planning

program and one with InterOptica for educational software, but the latter one had been terminated prior to March 1996. She confirmed that any computer programs sold by applicant under its mark would be by licensing agreements with others. She identified a copy of an e-mail communication which had been produced by applicant during discovery as evidence of a known incident of confusion, this communication describing the purchase by the sender of a game program bearing opposer's mark thinking it was a Sierra Club product.

Peter Beren, the prior licensing director of applicant, stated that he did not recall any programs sold by Microsoft or other licensees prior to September 20, 1993, which was in accord with applicant's answer to Request for Admission No. 2, in which applicant admitted that Microsoft did not sell computer programs identified by the mark SIERRA CLUB prior to September 20, 1993. He testified that InterOptica licensed the SIERRA CLUB mark for an educational software consisting of a series of CD-ROMS and disks, but he was not aware of any release of the product publicly prior to November 4, 1993. He stated that InterOptica was no longer in existence and any existing inventory of the software was simply sold off. He testified that the only present licensing agreement was with GeoTrek.

The Opposition

With respect to priority, opposer's submission of a status and title copy of its pleaded Registration No. 1,386,598 for the mark

is sufficient to prove ownership of this registration and thus to establish priority for opposer as to this mark when used in connection with the goods identified in the registration.⁹ See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Insofar as opposer's common law rights in the mark SIERRA alone are concerned, both for use with screen savers and entertainment and educational software, we must look to the evidence of record.

Opposer has established by this evidence that it was using its SIERRA mark in connection with screen savers by 1992 (Williams deposition p.20 and Exhibit 6). While applicant insists that the packaging shows use only of the mark SIERRA in connection with the mountaintop design, and that opposer's rights are so limited, we do not agree.

⁹ Although opposer also submitted status and title copies of Reg. No. 1,703,915, as previously noted, this registration has been cancelled and accordingly cannot be relied upon by opposer. Similarly, although a status and title copy of Reg. No. 1,788,288 has been submitted, there is no indication thereon that a Section 8 affidavit has been filed. Office records also do not show the filing of such an affidavit as of this date, although the affidavit was due by August 17, 1999. Accordingly, we have not given consideration to this registration either or to any of opposer's arguments with respect to ownership of a family of marks.

Although many of opposer's demonstrated uses of the term SIERRA for all varieties of its software are in close proximity to the mountaintop design, we are convinced that the word SIERRA functions as a mark in itself, even when used in this manner. The word SIERRA creates a separate and distinct commercial impression, even if accompanied by the mountaintop design, which varies in position from the left of the word, above the word, or farther in distance from the word.¹⁰ Accordingly, we find that opposer has established use of the mark SIERRA at least as early as 1992 for screen savers and as early as 1984 for computer game programs (Exhibits 9 and 10). This is clearly prior to any use by applicant of its mark SIERRA CLUB for computer programs (or the filing date of its application), and more particularly for screen saver programs, which were not introduced by its licensee Microsoft until at least September 20, 1993.

Thus, we turn to the issue of likelihood of confusion and to those factors which are most relevant to the circumstances at hand. See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The goods of the parties are virtually identical. Although opposer has established use of its SIERRA mark for

¹⁰ We note that the Examining Attorney found the specimens in both of opposer's pending applications for the mark SIERRA acceptable, although both showed use of the word SIERRA in close proximity to the mountaintop design.

a wide variety of computer programs, screen savers are specifically included therein. Applicant is limited, however, by its amended identification of goods to screen saver programs, and any evidence of use of its SIERRA CLUB mark on other types of computer programs is irrelevant.¹¹ See Canadian Imperial Bank of Commerce v. Wells Fargo bank, 811 F.2d 1490, 1 USPQ 1813 (Fed. Cir. 1987).

Because of this identity of goods, the channels of trade and potential purchasers must be considered to be the same. There is also evidence of record that licensee Microsoft sold the SIERRA CLUB screen savers in software stores and computer superstores, the same type of retail outlets in which opposer sells its various computer programs. In addition, Mr. Williams testified that opposer's software ranges in price from \$5 to \$79, whereas Ms. Sigmon testified that applicant's screen savers were originally priced at \$29.95 but later dropped as low as \$21.99. Thus, the goods involved here must be considered as impulse items, purchased without any great amount of deliberation by unsophisticated purchasers. All of these

¹¹ We note that although the issue of abandonment was not tried herein, the evidence indicates that applicant's screen savers are no longer being sold. Thus, if any appeal of our decision is made, and if our decision is reversed, applicant's application should be remanded to the Examining Attorney for the purpose of obtaining information as to present use of the mark in connection with screen savers.

factors, identity of channels of trade, of type of purchaser and of type of purchase weigh in opposer's favor.

Accordingly, a key factor is the similarity or dissimilarity of opposer's mark SIERRA and applicant's mark SIERRA CLUB. It is well established that in general the greater the similarity of the goods, the lesser the degree of similarity of the marks necessary to support a holding of likelihood of confusion. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Here opposer argues that SIERRA is the dominant portion of each mark, the only difference being the addition of the descriptive term CLUB by applicant. Applicant, on the other hand, insists that the marks must be considered in their entireties, with the respective compound marks being SIERRA and mountaintop design and SIERRA CLUB.

As previously discussed, we find opposer entitled to rely upon use of the mark SIERRA alone, separate from the design which forms a part of its registered mark. Furthermore, even if the word SIERRA were considered inseparable from the design feature, it is well established that there is nothing improper in giving more or less weight to a particular feature of a mark. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). When the word portion, rather than the design feature, is more

likely to be remembered and relied upon by purchasers in calling for the goods, the word portion is entitled to be given more weight. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p. A.*, 32 USPQ2d 1192 (TTAB 1994). Here the word SIERRA clearly dominates opposer's mark and would be used in referring to opposer's goods. If anything, the mountaintop design serves to reinforce the word portion of the mark, the mountaintop being described by John Williams as a depiction of Half Dome in Yosemite National Park, while the word SIERRA was adopted by opposer as a reference to the Sierra Nevada chain of mountains.

As such, we find the marks SIERRA and SIERRA CLUB create very similar overall commercial impressions. Both are dominated by the same word SIERRA and both contain the same reference to the Sierra Nevada mountains. Applicant's mark may readily be shortened to SIERRA; in fact, applicant has pointed out that it owns a registration for the mark SIERRA for its magazine. Applicant's argument that it is the only party which is entitled to rely upon use of the mark SIERRA alone simply emphasizes the similarity in commercial impressions between its mark and opposer's SIERRA mark.¹²

¹² Specifically, applicant argues in its brief that SIERRA CLUB is the only entity that has used the mark SIERRA alone and SIERRA CLUB has used that mark for more than 20 years in connection with its magazine. (Brief, p. 11).

While applicant argues that SIERRA is a weak mark, being both geographically descriptive of the Sierra Nevada range of mountains and a common surname, as well as the being the subject of several third-party registrations, applicant has failed to introduce any evidence to support these arguments. Opposer, on the other hand, has introduced testimony to the effect that it knows of no other users of SIERRA in connection with computer programs. Thus, the absence of evidence of use by others of similar marks for similar goods also weighs in opposer's favor.

Opposer further argues that its fame in the entertainment software industry is another factor in its favor. The testimony of John Williams is relied upon to demonstrate that opposer has attained a substantial position in this market.

In response, applicant once again argues that opposer is not entitled to rely upon use of the mark SIERRA alone in its claim of fame and that applicant is in fact the more established and famous user of the mark SIERRA, having used it for its magazine for twenty years.

The fame taken into consideration under the du Pont factors is generally that of the prior mark, or in other words, the mark of the prior user. Opposer has established

The dissent appears to ignore the fact that applicant has voluntarily made this reference to its use of the shortened form SIERRA and in fact claimed rights to the mark SIERRA alone.

that it is the prior user of the mark SIERRA for computer software programs. While applicant may be well-known as an environmental group operating under the mark SIERRA CLUB for the past 100 years, and opposer has acknowledged as much, its expansion into the field of computer software was strictly an auxiliary merchandising venture of recent years. Even though applicant has used the mark SIERRA for its magazine, this usage is correlated with its fame as an environmental group and does not reflect any recognition of the mark in the computer software field. Opposer is clearly the more well-known user of the mark SIERRA in the relevant market. Accordingly, this du Pont factor also weighs in favor of the likelihood of confusion.¹³

Finally, the factor of actual confusion must be considered. The only evidence which has been made of record is an instance of reverse confusion, opposer's product being mistakenly believed to have originated from applicant.¹⁴ While applicant argues that this is only a single isolated incident, we find this to at least provide evidence of the potential for confusion, if not the normal "forward

¹³ To the extent that applicant's mark is famous in its field, and to the extent that purchasers or users of screen savers would know of this fame, use of opposer's SIERRA mark for screen savers would tend to cause "reverse confusion," as discussed infra.

¹⁴ Contrary to the statements made in the dissent, we find evidence of at least initial confusion in the e-mail message, in that the mother stated that she gave her approval to her son's selection, after seeing the "familiar word I so lovingly respect Sierra."

confusion" in which applicant's screen savers would be likely to be presumed to originate with opposer, at least the less frequently arising "reverse confusion" in which opposer's screen savers and computer games would be mistakenly associated with applicant. Either type of confusion falls within the ambit of Section 2(d). See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1422 (TTAB 1993).

Accordingly, we find the factors which are relevant to the determination of likelihood of confusion in the present case weigh in favor of opposer. To the extent that any doubt may exist, this doubt must also be resolved in favor of opposer, as the prior user of its SIERRA mark in the computer screen saver field and against applicant as the newcomer.¹⁵ See *Century 21 Real Estate Corp. v. Century Life of America*, *supra*; and *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

¹⁵ We do not share the view voiced by the dissent that the owner of a famous mark should be allowed to register its mark for goods in a field far removed from its normal activities, when there is already a well known user of a highly similar mark in that field. If the owner of a famous mark does not timely object to a conflicting mark being used and registered in an unrelated field, then the owner of that famous mark should not be able to later expand use of and register its mark for goods or services in that once unrelated field, if there is in fact a likelihood of confusion.

Opposition No. 96,402

Decision: The opposition is sustained and registration is refused to applicant.

R. L. Simms

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board